Remarks/Arguments

The Rejection of Claims 1-10, 14-16, 19-32, 36-38, and 41-44 Under 35 U.S.C. §103

The Examiner rejected Claims 1-10, 14-16, 19-32, 36-38, and 41-44 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,339,767 (Rivette et al.) in view of U.S. Patent No. 6,154,725 (Donner). Applicants respectfully traverse this rejection as follows.

Claim 1

Figure 3 in Rivette '767 does not teach a publication website

Figure 3 shows clients, databases, networks, and servers, but does not show a publication website. Rivette '767 is concerned with processing, not publishing, data. As stated in the first sentence of the Abstract: "A system, method, and computer program product for *processing* (emphasis added) data are described herein." In the Summary of the Invention, Rivette '767 further describes the invention as maintaining databases and groups, performing processing functions such as patent and document mapping, and having the ability to display hyperbolic trees. Rivette '767 is silent regarding publication. Applicants performed a word search of Rivette '767 and discovered that the word "publication" is not used in Rivette '767. Therefore, Rivette '767 does not disclose the Claim 1 element of: "providing a searchable document database and a publication Web site in communication with a document database;"

Rivette '767 teaches against publication of data on a website

"The databases 316 and data contained therein are specific to the customer. For example, the databases 316 may contain information on the patents that the customer owns and/or licensees, and information on the patents that the customer's competitors owns and/or licenses. Also, the databases 316 may contain the customer's and the customer's competitors' R&D information, financial information, licensing information, manufacturing information, and HR information." (col. 16, lines 30-38). Rivette is clearly concerned with data that is not being published, but is being accessed for analysis. In fact, much of the data described is highly confidential, for example, R&D information, and publication of this data would be antithetical to the user of Rivette's system.

Figure 1 of Donner does not receive product documents from a client's computer

Figure 1 of Donner does not show a client computer as recited in Claim 1. The components shown in Figure 1 are the invention components (devices 2, 4, 6, 8, 10, and 12) or publicly accessible databases 5. "Figure 1 represents a block diagram representation of the proposed intellectual property audit system." (col.6, lines 11 and 12). Further, no mention is made of a product document with respect to Figure 1. Data input device 2 is used to input data regarding a portfolio to be acquired (col. 6, lines 12-14). Databases 5 and 12 contain patent information and empirical data from other patent portfolios. Therefore, Figure 1 of Donner does not disclose or suggest the Claim 1 element of: "electronically receiving a product document transmitted by a client's computer;"

Figure 2 of Donner does not publish a product document by adding the product document to a document database

Donner in general, and Figure 2 specifically, do not teach any type of publication. Further, Figure 2 does not add a product document to an invention system database:

> "In FIG. 2, the user of the audit system would input the appropriate data to an input device 14. In the most basic form, the input data might simply be a list of patent numbers for an intellectual property portfolio comprising only patents.
> Next, the data would be transmitted to a database access device 16 which would collect various data from different on-line intellectual property databases 18. The collected data represents different intellectual property worth indicators. Each worth indicator would then be assigned a value which would be approximated using previously collected indicator values which are based on intellectual property portfolios which have known worth or dollar values by consulting empirical database 22." (col. 5, lines 13-26).

Databases 18 in Figure 2 are on-line intellectual property databases – documents are not added to databases 18 by Donner. Database 22 contains means for calculating indicator values – Donner does not disclose adding documents to databases 22. Therefore, Figure 2 of Donner does

not disclose or suggest the Claim 1 element of: "publishing said product document by adding said product document to said document database"

Figure 2 in Rivette '751 does not teach publishing for the purpose establish a bar to patentability

Figure 2 in Rivette '751 does not teach the Claim 1 limitation of: "wherein said publishing is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product." Rivette '751, and Figure 2 in particular, teach gathering and processing data, not data publication: "FIG. 2 is a conceptual representation of the invention. The present invention processes patent information 204, which is herein defined to include (but not limited to) U.S. and non-U.S. patents (text and/or images) and post issuance documents (such as Certificates of Correction), and patent-related information, which includes information about patents (herein called patent bibliographic information). Accordingly, the processing performed by the invention is said to be "patent-centric" or "patent-specific." (col. 10, lines 8-16). Applicants are unable to find any reference in Rivette '751 that processing includes publication, especially publication to bar patentability.

The present invention is meant to be a very public and accessible process. That is, the goal of the present invention is to make a product document "sufficiently accessible to one skilled in the relevant art who exercise reasonable diligence" within the meaning of 35 U.S.C. §102(b). Hence, the present invention places publications in the public domain for purposes of establishing bars to patentability. On the other hand, the non-patent information in Rivette '751 includes very sensitive and confidential data: "More generally, the present invention processes any documents, some of which are related to patents, and others which are unrelated to patents. These documents are preferably of interest to a business entity, and include contracts, licenses, leases, notes, commercial papers, other legal and/or financial papers, etc., as well as patents." (col. 10, lines 17-22). Thus, Rivette '751 is disclosing a system and method for internal use by a corporate entity as part of its decision-making process. This is the antithesis of a public and accessible process. Business entities go to great lengths to ensure the confidentiality and secrecy of documents such as legal papers. Thus, Rivette '751 does not teach a Web publication site or

include any motivation or suggestion regarding a Web publication site, and in particular, publication to bar patentability.

There is no motivation to combine references

The Examiner has cited decreasing latency in document processing as the general motivation for combining Donner with Rivette '751 and '767. Applicants have shown supra that Donner with Rivette '751 and '767 do not teach or suggest the elements of Claim 1. However, assuming *arguendo* that Donner with Rivette '751 and '767 do teach or suggest any of the elements of Claim 1, there must be some teaching, suggestion, or motivation to combine the references and the teachings of the references can be combined only if there is some suggestion or incentive to do so. Applicants can find no suggestion in Donner or Rivette '751 or '767 that latency is a problem and, therefore, fail to see how latency can be a motivation to combine Donner with Rivette '751 and '767. Further, latency appears to be irrelevant with respect to the divergent problems addressed by Donner, Rivette '751 and '767, and the present invention. For example, decreasing latency will not improve the quality of the patent-centric and group-oriented data processing of Rivette '767 or the quality of the analysis performed by Donner.

In summary, the Examiner has not provided a motivation to combine references. Likewise, the fact that a modification would be within the ordinary skill of the art is not proof of motivation *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Applicants respectfully submit that the cited prior art is only modified in retrospect, in light of the present invention. That is, the obviousness rejection is based upon the Applicants' own invention characterization, not the modification of Rivette and Donner

For the reasons set forth above, Applicants respectfully submit that, with respect to Claim 1, Rivette '767 in view of Donner and further in view of Rivette '751 fail to satisfy the requirements for establishing a *prima facie* case of obviousness in accordance with MPEP § 2143. Therefore, Claim 1 is patentable over the cited prior art and Applicants respectfully request that the rejection be withdrawn. Claims 2-10, 14-16, and 19-22 depend from Claim 1, which is patentable in light of the cited references. Thus, Claims 2-10, 14-16, and 19-22 also are patentable in light of the cited references.

5

Claim 23

The Examiner has stated that Claim 23 is parallel with Claim 1 and rejected for the same reason. Therefore, Applicants respectfully submit that with respect to Claim 23, Rivette '767 in view of Donner and further in view of Rivette '751 fail to satisfy the requirements for establishing a *prima facie* case of obviousness in accordance with MPEP § 2143. Therefore, Claim 23 is patentable over the cited prior art and Applicants respectfully request that the rejection be withdrawn. Claims 24-32, 36-38, and 41-44 depend from Claim 23, which is patentable in light of the cited references. Thus, Claims 24-32, 36-38, and 41-44 also are patentable in light of the cited references.

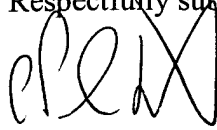The Objection of Claims 11-13, 17, 18, 33-35, 39, and 40 as Being Dependent Upon a Rejected Base Claim

Claims 11-13, 17, 18, 33-35, 39, and 40 were objected to as being dependent upon a rejected base claim, but the Examiner indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have shown that Claims 1 and 23 are patentable over the cited prior art. Therefore, Applicants respectfully submit that Claims 11-13, 17, and 18, dependent from Claim 1, no longer depend upon a rejected base claim; and, Claims 33-35, 39, and 40, dependent from Claim 23, no longer depend upon a rejected base claim. Applicants respectfully submit that these claims are now in condition for allowance, which action is courteously requested.

Conclusion

Applicants respectfully submit that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,

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